C. Remarks

The claims are 6-9, 15, 17-19 and 25-27, with claims 6 and 15 being independent. Non-elected claims 1-5, 10-14 and 20-24 have been cancelled without prejudice or disclaimer. Claims 6-9, 15 and 26 have been amended for clarification and to address formal issues raised by the Examiner. New claim 27 has been added. Support for this claim may be found, *inter alia*, in Fig. 2 and the corresponding discussion in the specification. No new matter has been added. Reconsideration of the present claims is expressly requested.

Claim 6 is objected to due to a minor informality.

Since claim 6 has been amended to correct the informality, the objection should be withdrawn.

Claims 6-9, 15, 17-19, 25 and 26 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite.

Specifically, the Examiner has rejected various claims for the alleged failure to recite active process steps and cited *Ex parte Erlich*, 3 U.S.P.Q.2d 1011 (Bd. Pat. App. & Inter. 1986) for support. Applicant respectfully disagrees.

The claims recite the steps of reading, analyzing and the like. These are clearly active steps compliant with the statute. Furthermore, *Ex parte Erlich* relates to so called "use" claims, which is clearly not the case with respect to the subject application.

The Examiner also alleged that the phrase "determining whether or not the subject is a new subject by comparing the first personal identification code obtained in the identification step with a second personal identification code registered in a database" is indefinite because it is not clear how one would determine if the subject is new by

comparing the subject's personal identification code to only a single code in the database. The Examiner notes that the code should be checked against the entire database.

In response, claim 6 has been amended to recite a comparison with all personal identification codes in the database.

Further, the Examiner alleged that the term "hybridization pattern read" recited in various claims lacks sufficient antecedent basis even though the reading step in claim 6 recites "reading a hybridization pattern".

In response, the claims have been amended to delete the word "read".

The Examiner alleged that the phrase "a storage unit configured to store the subject" is indefinite, because it pertains to state that the actual subject is being stored.

In response, claim 7 to clarify that information is being stored.

Lastly, the Examiner alleged that the following recitation in claim 26 is indefinite: "wherein the DNA microarray includes a code for identifying itself". Specifically, the Examiner alleged that it is not clear how the code identifies the microarray (test subject, disease, etc.).

Claim 26 has now been amended to clarify this issue.

In view of the above-noted amendments and remarks, withdrawal of the indefiniteness rejection is respectfully requested.

Claims 6, 7, 15, 18 and 25 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from U.S. Patent No. 5,876,926 (Beecham) in view of U.S. Patent No. 6,187,450 B1 (Staub) and 6,905,827 B2 (Wohlgemuth). Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Beecham, Staub and

Wohlgemuth in view of U.S. Patent No. 6,362,004 B1 (Noblett). Claims 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Beecham, Staub and Wohlgemuth in view of U.S. Patent No. 6,021,393 (Honda). Claims 26 stands rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Beecham, Staub and Wohlgemuth in view of U.S. Patent Application Publication No. 2001/0012537 A1 (Anderson). The grounds of rejection are respectfully traversed.

Prior to addressing the merits of rejection, Applicant would again like to briefly review some of the features and advantages of the presently claimed invention. That invention, in pertinent part, is related to a method for using a DNA microarray to both analyze a specimen collected from a subject and to identify the subject. To achieve this goal, the DNA microarray contains at least two DNA probe groups. The first DNA probe group can be used to identify the subject. The second DNA probe group can be used to test a specimen from the subject. A hybridization of state of each DNA probe in the first DNA probe group is analyzed to identify the subject. A hybridization of state of each DNA probe in the second DNA probe group is analyzed to generate test information. As a result, according to the present invention, both the identification of the test subject and a test for a disease can be performed using the same sample (specimen) at the same time without the subject being present for identification purposes or using any other means of identifying the subject.

Beecham is directed to a method and an apparatus for obtaining biometric data from a test subject for identification and testing a sample obtained from the test

subject. However, as acknowledged by the Examiner, Beecham fails to disclose or suggest performing these two processes using a single microarray.

Staub is directed to various methods for genetically identifying infants. While one of these methods utilizes a microarray, there is still no disclosure or suggestion of a combined use of the microarray as claimed. Furthermore, Staub does not disclose or suggest comparing the first identification code or number acquired from a DNA microarray with the second identification code or number stored in a database.

Wohlgemuth is directed to diagnosing and monitoring an autoimmune or chronic inflammatory disease by detecting expression levels of at least one gene. However, like Beecham and Staub, this reference does not disclose or suggest comparing the first identification code or number acquired from a DNA microarray with the second identification code or number stored in a database.

The Examiner has alleged in the Office Action that the present claims have no active process steps for obtaining an identification code from a hybridization pattern. Applicant respectfully disagrees.

As discussed above, the present claims clearly recite active process steps that comply with statutory requirements. In particular, claim 6, in relevant part, states:

> . . . analyzing a hybridization state of each DNA probe obtained from
> the first DNA probe group in the hybridization pattern in the reading
> step to acquire a first identification code that distinguishes the subject.

This claim clearly recites acquiring an identification code of the subject by analyzing the hybridization pattern. Independent claim 15 has similar language. Neither Beecham, Staub nor Wohlgemuth discloses or suggests a method in which the same specimen is used

to identify the subject and to test for a disease based on DNA hybridization at the same time using the same biochip.

Noblett, Honda and Anderson cannot cure the deficiencies of Beecham, Staub and Wohlgemuth. Noblett was cited by the Examiner for a teaching of fiducial marks on a microarray. Honda was cited for a teaching of portable memory cards carried by patients. Anderson was cited for a teaching of using identifiers on microarrays. However, even if assumed, *arguendo*, that these references contain the alleged teachings, they still lack the same disclosure that is missing in Beecham, Staub and Wohlgemuth.

In conclusion, Applicant respectfully submits that the cited references, whether considered separately or in any combination, fail to disclose or suggest the presently claimed elements.

Wherefore, withdrawal of the outstanding rejection and expedient passage to issue are respectfully requested.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Jason M. Okun/
Jason M. Okun
Attorney for Applicant
Registration No.: 48,512

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200